REMARKS

Claims 1-72 are pending. Claims 1, 18, 21 and 69 were rejected. Claims 2-17, 19-20 and 70 were objected to. Claims 33-68 and 71-72 are allowed. Reconsideration and allowance of the application are respectfully requested in view of the following remarks. Although pending, claims 22-32, which depend from rejected claim 21, appear to have been accidentally omitted from the Office Action Summary page. The indication that "Applicant's arguments see page 43-45, filed 04/15/09, with respect to claims 1-72 have been fully considered and are persuasive. The rejection of claims 1-72 has been withdrawn." is noted with appreciation.

Claim Rejections – 35 U.S.C. §101

Method claims 1, 18, 21, and 69 are independent and stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicant respectfully traverses this rejection.

The test for statutory subject matter is set forth in *In re Bilski*, 2008 WL 4757110 (Fed. Cir. October 30, 2008) as:

> A claimed process is surely patent-eligible under §101 if:
> (1) it is tied to a particular machine or apparatus, or
> (2) it transforms a particular article into a different state or thing.

Additionally, elements (1) and/or (2) should impose meaningful limitations on claim scope and (2) should not be merely insignificant post-solution activity.

Applicant incorporates by reference, and maintains, the remarks on pages 38-43 of Applicant's Reply filed on April 15, 2009 that explained why each of each of independent claims 1, 18, 21, and 69 satisfy prong (1) and/or (2) of the *In re Bilski* test.

Page 2 of the present Office Action states, in pertinent part (emphasis added):

> It is the office position that the steps provided within the method claims are not required to be performed by a particular machine or apparatus. *Further, it is the office position that a mere manipulation of data – for example data transformation from digital to analog is not equivalent to the physical transformation as*

> *required by In re Bilski. The data signal starts out as an electromagnetic wave and remains such after processing.*

Respectfully, these comments fail to take into account each and every feature (and combinations of features) recited in each of claims 1, 18, 21 and 69. Had they done so, it would be clear that each of claims 1, 18, 21 and 69, expressly requires more than a mere "data transformation from digital to analog".

More importantly, however, the comments about the "…office position…" are expressly contrary to *In re Bilski*, which recites in pertinent part (emphasis added):

> … In contrast, we held one of Abele's dependent claims to be drawn to patent-eligible subject matter where it specified that "said data is *X-ray attenuation data* produced in a two dimensional field by a computed tomography scanner." Abele, 684 F.2d at 908-909. This data clearly represented physical and tangible objects, namely the structure or bones, organs, and other bodily tissues. *Thus, the transformation of that raw data into a particular visual depiction of a physical object on a display was sufficient to render that more narrowly claimed process patent eligible….* (*Bilski*, Page 26 of 2007-1130, October 30, 2008).

Interestingly, raw x-ray data is an electromagnetic wave (or series of electromagnetic waves) and a "particular visual depiction of a physical object on a display" is also that same electromagnetic wave (or series of electromagnetic waves) after "manipulation" and/or "processing."

Accordingly, Applicant respectfully submits that claims 1, 18, 21 and 69, and dependent claims 2-17, 19, 20, 22-32 and 70, are each patent-eligible under the *In re Bilski* test.

Turning now to page 3 of the present Office Action, which states, in pertinent part (emphasis added):

> ….While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. *For example, the method for providing multiple images for transmission across an analog interface including the steps of "receiving", "creating", "merging", and "providing" is of sufficient breadth that it would be reasonably interpreted as a series of steps completely*

> *performed mentally, verbally, or without a machine*. The Applicant has not tied the method for providing multiple images for transmission across an analog interface including the steps of "receiving", "creating," merging" and "providing"to a particular apparatus to perform the method as claimed.
>
> The Applicant has provided no explicit and deliberate definitions of "receiving", "creating", "merging" and "providing" to limit the steps to the electronic form of the method, and the claim language itself is sufficiently broad to read on a printout, mentally stepping through the §101 analysis.

These comments are respectfully traversed.

To begin, when each of these claims is read and considered in its entirety, its language makes clear, without the need for inference or deduction, that these methods cannot be performed merely by "mentally stepping through the §101 analysis" or "…mentally, verbally, or without a machine" for the simple reason that Applicant is not aware of, and the Office Action is silent regarding, any reference or citation to scientific or legal documents that would prove the faulty premise of this reasoning: namely that the human mind is identical or equivalent to:

(a) an "analog interface" (e.g., a "video analog transmission interface") as recited, in combination with the other features, of claims 1 and 21;

(b) a "first analog interface", a "second analog interface", "a first analog display device" or a "second analog display device" as recited, in combination with the other features of claim 18;

(c) an "analog interface" or a "digital interface" as recited, in combination with the other features, of claim 69.

Moreover, the Office Action also lacks legal or scientific proof to support another faulty premise: namely that the human mind is capable of handling either a "digital input data stream" or an "analog image output stream", as recited, in combination with the other features of each of claims 1, 18, 21 and 69. Put simply, this rejection lacks merit because it defies common sense.

Secondly, these Office Action comments incorrectly attribute the word "including" to claims 1, 18, 21, and 69, when in point of fact, each of these claims recites the word "comprising".

Finally, the test for patentable subject matter under *Bilski* is not whether Applicant has provided "explicit and deliberate definitions" of claim terms or claimed features. It is also not whether each and every claimed feature is tied to "…a particular machine or apparatus." Rather, as stated previously, the test for statutory subject matter is set forth in *Bilski* as:

A claimed process is surely patent-eligible under §101 if:

(1) it is tied to a particular machine or apparatus, or

(2) it transforms a particular article into a different state or thing.

Prong (1) of this test addresses the claimed process as a whole. Accordingly, a method (or process) claim, such as each of claims 1, 18, 21 and 69, that has at least one feature tied to a particular machine or apparatus, meets and passes this test. As noted above, claims 1, 18, 21 and 69 are each also believed to satisfy prong (2) of this test.

For at least these reasons, Applicant respectfully requests that the non-statutory subject matter rejection of claims 1, 18, 21 and 69 be withdrawn and all of these claims passed to allowance and issue, it being understood that claims 2-17, 19, 20, 22-32 and 70 which depend from allowable independent claims 1, 18, 21, and 69 are also allowable, at least by virtue of their respective dependencies, as well as for their added features.

CONCLUSIONS

For at least the reasons referenced above, Applicant respectfully requests issuance of a Notice of Allowance.

Applicant's failure (if at all) to expressly address above any particular statement or argument by the Examiner should not be construed as an admission or acquiescence that such statement or argument is accurate or proper.

The Examiner is respectfully invited to contact the undersigned if there are any remaining issues that can be resolved by telephonic communication.

Favorable action is respectfully requested.

Respectfully submitted,

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